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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,966	10/29/2003	John Carcich	372-001CIP2	8506

7590 04/11/2006

John Carcich  
1649 Luika Place  
Campbell, CA 95008

EXAMINER
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ZEMEL, IRINA SOPHIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/696,966

Applicant(s)

CARCICH, JOHN

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 19-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Invention Group I, claims 1-18 in the reply filed on July 20, 2005 is acknowledged. Since applicants provided NO arguments in support of the traversal of the restriction requirement, the election is treated as election without traverse.

Claims 19-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Priority***

This application is claiming the benefit of prior-filed nonprovisional applications No. 09/552,360 which was ABANDONED on 3-7-2003 and No. 09/678,162, which was ABANDONED on 5-1-2003, under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

### ***Claim Rejections - 35 USC §103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as obvious over EP 1148085 to Carchich et al., (hereinafter "Carcich") in combination with either US Patent 6,353,146 to Williams, (hereinafter "Williams") or Utilization of Natural Zeolites in Japan, pp. 441-449, (hereinafter "Natural Zeolites"), and further in combination with SU 715124 to MHTI.

Applicant should note that the priority claimed to earlier filed application was NOT accorded in this application due to lack of co-pendency (see statement above), thus, the effective filing date for the instant application is the actual filing date of this application, i.e., 10-29-2003, and the cited reference constitutes a prior art reference under the provisions of 35 USC 102 (b) .

Carcich discloses rubber compositions obtained by blending of between about 10 weight percent to 90 weight of a material selected from the group consisting of natural rubber, synthetic rubber, and plastic; and between about 85 weight percent and 5 percent of a zeolite. Carcich further discloses all of the claimed additives and all of the specific components that correspond to the additives and components of claims 2-10 and 12-18. See illustrative examples. Furthermore, in the specification of the instant application, the applicants state that the technology of rubber compounding used in the instant invention is old, and majority of the additives are known in the art. See page 5 of the instant specification. The reference does not disclose the size of the used zeolites, thus implying that zeolites of all known sizes are suitable for the invention. Williams

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(especially columns 5-6) and Natural Zeolites (especially pages 445-46) disclose that zeolites with the claimed particle size are known in the art, and further disclose the effect of the size on the abrasive and other properties of the materials using zeolites with different particle size, and the claimed size is preferred size for absorbent articles. Therefore, use of specifically claimed size zeolites would have been obvious as known in the art with reasonable expectation of adequate results and in the absence of unexpected results. While the instant specification states that zeolites with specified size work better, there is no evidence on the record that any of the properties of the resulting compositions are, in fact are unexpectedly improved.

The Carcich reference further is silent regarding the drying of the zeolites. However, it is noted that the claims 1-10 are directed to the product, and not the process, and the drying step is not required for the process step. (It is suggested that the drying step of the claimed zeolites is included in the process claims as the first positive step, i.e. "A method ... comprising: drying a zeolite...., adding said zeolite..." to positively require the drying step in the claimed process.) As far as the product claims 1-10, the patentability of the product does not depend on the process the product is obtained. In the instant case, it is irrelevant whether the zeolite was dried or not prior to the addition to the rubber, as long as the final product (as claimed) is not patentably different from the product disclosed in the cited art. In the instant case it is reasonable believed that the claimed product utilizing dried zeolite is the same as the product disclosed in the Carcich reference since all of the properties of the compositions disclosed in illustrative examples of the reference are identical to the properties of the

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products disclosed in the instant application. The burden is shifted to the applicants to provide factual evidence to the contrary.

As far as the process claims, again, the drying step is not positively claimed and only refers to the product (similarly to the process step). Thus, the same rationale as discussed in the product claims is applicable to the process claims. In the alternative, SU reference discloses that drying of zeolites at temperatures of as low as 100 C improves adsorptive capacity and mechanical strength of the zeolites, thus making the claimed drying obvious for the expected improvement in the zeolite properties.

Thus, the invention as claimed is considered to have been obvious from the teachings of the above cited reference.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP 09234264 discloses rubber compositions containing zeolites and other additives as effective odor absorbents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irina S. Zemel  
Examiner  
Art Unit 1711

ISZ

A handwritten signature in black ink, appearing to read 'Irina S. Zemel', is positioned below the printed name and title.